

Single Colour Marks a Gray Area: An Attempt to Re-Tool the Indian Legal Framework

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ABSTRACT

The idea of trademarks is not a recent invention; it dates back over a considerable period of time. However, as times changed, it significantly evolved and got refined. With new developments and innovations have come about over time, different classes of marks have requested protection in the area of trademark law. However, not all of these marks were accepted to the same degree. One such particular class of mark is the single colour mark. The tussle over the registrability of single colour marks is the ongoing discourse which has the potential to generate wide-ranging ramifications for the trademark law. Different jurisdictions have attempted to solidify their legislative framework in response to single colour marks. However, there exist jurisdictions like India which are still searching for the correct path.

The present paper makes an attempt to contribute to the existing set of literature by structuring the approach in relation to the issue of registering and validating the single colour marks within Indian legal framework. The paper makes an exploration to the Acts, Rules, Judicial Dictums and suitable foreign learnings in a structured manner for unravelling the conundrum persisting over the validity of single colour marks within the jurisdiction of India.

KEYWORDS: Trademark, Secondary Meaning, Distinctiveness, Functionality, Single Colour Marks.

INTRODUCTION

The concept of trademarks is not a novel development, it stems from ancient times. However, with changing times, it got evolved and refined to a significant level. With new developments and innovations in time, different classes of marks have claimed protection within the arena of trademark law. But not every such mark received the same level of acceptance. Single colour mark is one such specific class of mark. Single colour mark has been a very contentious and debatable topic with wide ranging arguments in favour and against of granting it the legitimate protection within the ambit of trademark law.

There are not any uniform set of rules or guidelines governing this burning issue. Proponents of it have their own set of reasons and even attempted to lay down the list of high standards for enabling the protection to single colour marks. While opponents view it as a complicated and uphill task with wide ranging ramifications. Even different jurisdictions in the international arena define and govern the law related to single colour marks in their own perspective with some in favour while others in against of it. Countries like USA and EU having most evolved jurisprudence over intellectual property rights with time recognised single colour marks as a valid trademark.

These countries have in fact through judicial engineering have over time developed a definite list of conditions which have to be met by single colour marks in order to be enunciated as a valid trademark. But India where the law related to intellectual property rights is still in a nascent stage, courts have given

a variety of incompatible decisions with no conclusive instruction determining the same. Therefore, in light of the above, an effort needs to be made to streamline the jurisprudence in relation to single colour marks within the jurisdiction of India, keeping in view the international jurisprudence specifically of USA and EU, trademark laws and rules of Indian jurisdiction and judicial approach of Indian courts.

The present research paper makes an attempt to contribute to the existing set of literature by structuring the approach in relation to the issue of registering and validating the single colour marks within Indian legal framework. The first part of the paper explains the dynamics of single colour marks with plausible concerns and theories against the registration of single colour marks. The second part of the paper seems to witness the development of international jurisprudence of single colour marks vis-à-vis USA, EU. The third part of the paper tries to mainstream the international legal framework witnessed in the second part of the paper over the registrability of single colour marks by listing and defining the necessary standards upon the fulfilment of which a valid protection would be granted to single colour mark. The last and most important part of the paper takes a step to analyse the prevailing underpinnings in relation to single colour marks within Indian jurisdiction and tries to develop a way forward for unravelling the legal conundrum in light of the overall discussion in the paper.

UNDERSTANDING THE CONCEPT OF SINGLE COLOUR MARKS AND THE PLAUSIBLE ARGUMENTS ADVANCED AGAINST IT

This chapter makes an attempt to explore and develop an understanding about the single colour marks. It gives a brief idea about what actually are the single colour marks. Further the chapter entails the description of plausible concerns and theories against the registrability of single colour marks. The aim of this chapter is to develop a basic conceptual framework which would help in understanding the intricacies of subsequent characterisations of this paper.

Trademarks undeniably plays a vital role in brand building and brand identification. The rationale of the trademark is to give an indication to the consumer about the manufacturer and the grade of the products and to provide him the ability to distinguish goods and services of one person from those of others. With growth in innovation and developments of novel concepts of brand building, new classes of marks sought the protection under the trademark laws. Companies have been consistently asserting for the identification of colours with their products. Colour has been a strong factor in commercial transactions. Colour was earlier protected as a part of bigger schemes that includes words, designs, symbols or other distinguishing marks. But colour per se (single colour marks) has not enjoyed an easier trademark protection regime. Single colour marks usually face a restrictive and stricter registration criteria. Granting protection to single colour marks is often seen as counter-productive and anti-competitive.

A single colour mark is basically understood as a single colour used on a part of or the whole surface of a product or an item for exhibiting a service or for the packaging of a product. It also includes a single colour used in logos and advertisements. Earlier, the single colour marks were not awarded protection by the trademark laws of different countries, however, with time through judicial engineering, few countries have attempted to extend protection to it. As per the history of US trademark laws, single colour was not seen as something which could be protected, however, with course of time US judiciary made it clear that it could gain protection provided that it is not functional in nature and must have earned a secondary meaning.

PLAUSIBLE CONCERNS AGAINST THE REGISTRABILITY OF SINGLE COLOUR MARKS

Despite of the fact that few jurisdictions have been able to award protection and register the single colour marks, but it haven't been remain free from doubt. Many researchers and even judicial authorities from time to time expressed their concerns against the registrability of single colour marks. Registration of single colour marks has consistently witnessed disapproval and condemnation. Ownership of a colour is perceived as anti-competitive in nature. Monopolisation of colour has been argued as owning the unownable resources.¹ Let's discuss some of the fundamental concerns put forward against the registrability of single colour marks.

- 1. Colour Exhaustion or Depletion Theory:** This theory is based upon the foundation stone of just and fair competition. The propounders of this theory asserts that colours are limited in number, if an individual is permitted to trademark a specific colour then soon the list of all available colours will dry up and thereby result in preventing the future competitors from entering into the market. In the case of *Diamond Match v. Saginaw Match*², the US court observed, "*the primary colours, even adding black and white, are but few. If two of these colours can be appropriated for one brand of tipped matches, it will not take long to appropriate the rest. Then, competitors will not be able to market a product when all the colours for covering the goods are gone.*"
- 2. Shade Confusion or Likelihood of Confusion Theory:** The foundational tenet of trademark act is that no trademark should be given if it creates confusion or likely to lead the general public to be confused about the source of goods. This argument against registration is based on this tenet. The *shade confusion theory's* proponents claim that litigations across the trademarks utterly become confusing if different colour tones are permitted registration thereby resulting in *likelihood of confusion*³. Despite the development of color-identification systems (like Pantone), establishing whether a trademark sought to be registered is "deceptively similar" shall be a very complex process for the courts; as a result, this idea is predicated on the actual application of the single-colour rule.
- 3. Functionality Theory:** A trademark is said to be functional in nature when it is "*essential to the use or purpose of the product or affects the cost or quality of the product.*"⁴ It has been time and again observed by the judicial authorities that the trademark can be protected and registered if it is not functional in nature. The US Supreme Court in the case of *Qualitex*⁵ made a renowned observation about the functionality theory. As per the court, "*a trademark shall be registered unless exclusive use of the feature would put competitors at a significant non-reputation related disadvantage.*"
The functionality feature of a trademark can be categorised into two types i.e. utilitarian functionality and aesthetic functionality. The legal pronouncements over the utilitarian functionality is very much clear and definite while it is very much unclear and dispersed over the aesthetic functionality. If a color is necessary for the item's usage or purpose or has an impact on its price or quality, it is considered utilitarian functional. In the case of *Blue Frozen Desserts (Ambrit v. Kraft)*⁶ where the court applies utilitarian functionality and rejected the colour trademark. The court rejected the Ambrit's request for protecting the blue colour on the premise that the colour royal blue which is used for packaging

¹ Charlene Elliott, *Purple Past: Colour Codification in The Ancient World*. 33 LAW AND SOCIAL ENQUIRY, (2008).

² 142 F. 727, 729(6th Cir. 1906).

³ Peter Koebler, *Qualitex Co. v. Jacobson Products Co., 115 S. Ct. 1300 (1995): It Is Possible to Trademark Color Alone?*. 12 SANTA CLARA HIGH TECHNOLOGY LAW JOURNAL. (1996).

⁴ Emilie Winckel, *Hardly A Black-And-White Matter: Analysing the Validity and Protection Of Single-Color Trademarks Within The Fashion Industry*. 66 VANDERBILT LAW REVIEW. (2013).

⁵ *Qualitex Co. v. Jacobson Products Co.*, 514 U.S. 159 (1995).

⁶ *Ambrit v. Kraft*, 805 F.2d 974 (11th Cir. 1986).

purposes of frozen desserts is functional in nature and the same cannot be trademarked. Functionality may also be aesthetic in nature when consumers purchase the products for their aesthetic appeal. For the assessment of aesthetic functionality, apart from satisfying the test of utilitarian functionality, an additional factor needs to be ascertained for finding out aesthetic functionality, a feature is functional in nature if its usage would put the competitors at a competitive disadvantage.

DEVELOPMENTS IN INTERNATIONAL JURISPRUDENCE OF SINGLE COLOUR MARKS vis-à-vis USA, EU

This chapter entails the evolution and growth made with respect to single colour marks in the international perspective. The chapter makes an attempt to understand the approach furthered by most advanced jurisdictions in the intellectual property rights domain. The main aim of the chapter is to make aware the readers about what actually is the direction of judicial pronouncements vis-à-vis single colour marks.

UNITED STATES OF AMERICA

The road for the protection and registrability of single colour marks was not so smooth within the trademark law of USA. It has witnessed a long battle of judicial interpretations and pronouncements and is still facing today in some form or the other, however, now the position of single colour marks got more or less settled. Let's have a brief understanding of the developments in the jurisprudence of single colour marks within US in phased-wise manner.

Phase I: Before 1950s

Initially, the US trademark law was very much unwilling to accommodate the registration of single colour marks within the trademark jurisprudence. One of the early cases which can be referred for the reflection of such reluctance is of *Leshen & Sons Rope Co. v. Broderick Jacobson Products Co.*⁷ in 1906 wherein the court observed that colour may not be available to be registrable as trademark as it fails to meet the primary function of trademark. The court categorically stated, “*Whether mere color can constitute a valid trade-mark may admit of doubt. Doubtless it may, if it be impressed in a particular design, as a circle, square, triangle, a cross, or a star. But the authorities do not go farther than this.*”

However, the passage of Lanham Act, 1946 provided a ray of hope for granting the protection to colour marks. The wider interpretation of the Lanham Act may open the gateways for the colour marks, however, it does not explicitly provide for the protection to colour marks. But the US Courts were reticent to accommodate colour marks per se by employing the broad interpretation of the Lanham Act, 1946. The decision of the US Second Circuit Court in the case of *Campbell Soup v. Armour & Co.*⁸ in 1949 can be cited as an example of it, wherein, the court observed that the fundamental worry in permitting one business to monopolise red in all of its shades would reduce competition in the soup market.

The major arguments advanced against the registration of single colour marks by the US courts in this phase was the *Colour Depletion Theory* as granting protection to single colour marks would lead to monopolization of colours which although are limited in nature and thus would hinder competition. Another ground for the refusal of colour marks as embarked upon by the US courts is *Shade Confusion Theory*. as confusion over the perception of colours due to different factors would always open the

⁷ 201 US 166, 171 (1906).

⁸ 81 USPQ 430.

pandora's box for competitors and courts as to whether a particular shade in question infringes a persisting colour mark or not.

Phase II: 1950s to 2000

As per the history of US trademark laws, single colour was not seen as something which could be protected alone. Colour was earlier protected as a part of bigger schemes that includes words, designs, symbols or other distinguishing marks. However, with time and advancement in technology, the judicial approach with respect to registering the single colour marks witnessed a momentous shift. The first case as decided by the Federal Circuit Court which allowed colour per se to be registered as trademark was *In re Owens-Corning Fiberglas Corp*⁹. This was the first case which changed the landscape of US trademark registration. However, the said decision faced much hesitance and several courts of appeal were unwilling to accept the dictum of *Owens-Corning*. Lastly, the position was settled by the US Supreme Court in the case of *Qualitex Co. v. Jacobson Products Co.*¹⁰ Let's have a brief overview of both these cases.

- ***In re: Owens-Corning Fiberglas Corp.***

Owens-Corning had used the colour pink for its fibreglass insulation and advertised it extensively and even ran a campaign with the "Pink Panther" character, so that pink insulation be identified with Owens-Corning by the consumers. The Federal Circuit court through an expansive and liberal legislative reading observed that colour per se (single colour mark) could be registered as trademark. The Lanham Act, 1946 was analysed by the Federal Circuit court, which concluded that its purpose was to liberalise the law governing trademark registration. The vast scope of the Lanham Act was found to be in conflict with the colour depletion theory. The court concluded that the use of the color pink was not merely ornamental when assessing the extent of acquisition of secondary meaning because Owens-Corning had spent 42 million USD on advertisements since 1956 and because consumers also associated pink fiberglass with the manufacturer's goods. Furthermore, no other producer in the fiberglass sector was using pink fiberglass, supporting the theory that the color was not naturally useful.

- ***Qualitex Company v. Jacobson Products Company Litigation***

In this case, the plaintiff since 1950s used a 'green-gold' colour on their dry-cleaning pads and registered the trademark of green-gold colour in 1991. In the meantime, defendant also initiated the making of dry-cleaning pads with similar green-gold colour. The US Supreme Court while examining the issue observed that the Lanham Act allows the registration of simply of a colour as trademark. However, the registration could only be made if the colour has acquired the secondary meaning and the same shall not be functional in nature. The court categorically stated that, "*If a shape, a sound and a fragrance can act as a symbol why, one might ask, can a colour not do the same?*"

The court answered all the concerns put forth before it in a well-structured manner. First, in response to the shade confusion issue, the court stated that resolving infringement concerns involving colours is comparable to resolving infringement issues involving word marks or form marks. Additionally, the court stated that it could recreate the lighting conditions in which the products are typically viewed in the event that lighting conditions alter how colour is perceived. Second, the "colour depletion" defence was disproved on the grounds that "it relies on an infrequent issue to justify a general prohibition." Additionally, the functionality theory forbids the registration of any colours that are accidental to the use of the product, ensuring that new competitors can use the necessary colours. Third, the Owens-Corning

⁹ *In re Owens Corning Fiberglas*, 774 F.2d 1116 (Fed. Cir. 1985).

¹⁰ *Ibid* at 4.

ruling was used by the court to rule that the magnitude of the Lanham Act was much more wider than the previous trademark regulations.

This phase in actual terms through its two main judicial pronouncements acted as a pillar for laying down the structure of single colour marks. The two fundamental essentials for the registration of single colour marks that can be derived from the understanding of this phase is: (i) colour mark should be non-functional in nature and (ii) it should acquire a secondary meaning.

Phase III: After 2000s

The position in relation to single colour marks at this phase got somewhat settled especially after the *Qualitex*¹¹ decision. Of course, there was buzz around this topic but the US courts seems to acknowledge the single colour marks. The position got more affirmed by the decision in the case of *Wal-Mart Stores v. Samara Bros.*¹² wherein the court observed that colour mark per se is registrable provided if it acquires distinctiveness through a considerable use.

However, the major disputes in this phase pertains to the issue of colour's functionality especially aesthetic functionality in the context of fashion. The dust over the aspect of aesthetic functionality is still not settled and continues to be re-evaluated on a case-to-case basis. However, it considered much weaker in nature than utilitarian functionality.

EUROPEAN UNION

The path for the registration and protection of non-conventional trademarks especially single colour marks within European Union was not easy. Such cases for registration are considered to be problematic in nature. Though member states of EU especially Germany tried to accord a certain degree of protection to colours but they faced enormous difficulties in developing optimum principles for protecting single colour marks. However, with time, the trademark laws of EU along with European Court of Justice developed high standards for granting protection to single colour marks. Let's have a brief understanding of the developments in the jurisprudence of single colour marks within EU in phased-wise manner.

Phase I: Till 2000

In the majority of European nations, colours could not be registered as trademarks until the early 1990s. As an example, colours were only given a limited amount of protection in Germany under the rules of unfair competition law or as trade dress under the definition of trademark law (which required that the colour have attained a high degree of recognition among the concerned public). The courts of member states tried to extend protection to colours but witnessed difficulties in developing viable principles for protecting colours as trademarks.

Phase II: After 2000-2010

This phase is basically called as the foundation stone for the jurisprudence of single colour marks in European Union. Before this phase, there was not any definitive approach followed for evaluating the dimensions of single colour marks, however, the ECJ in its landmark judgment of *Libertel Groep BV v. Benelux-Merkenbureau*¹³. set up certain standards for protecting single colour marks which brought a tectonic shift in the chapter of European Union trademark registration.

Apart from this, European Union opened the gateway to modernisation by introducing the Trade Harmonisation Directive named Directive 2008/95/EC. Article 2 of the Trademarks Directive 2008/95/EC

¹¹ *Ibid* at 4.

¹² *Wal-Mart Stores, Inc. v. Samara Brothers, Inc.*, 529 U.S. 205 (2000).

¹³ *Libertel Groep BV v. Benelux-Merkenbureau*, [2003] ECR I-3793.

(The Directive) provides for the essentials that a valid trademark must possess. The said article speaks, “A trade mark may consist of any signs capable of being represented graphically, particularly words, including personal names, designs, letters, numerals, the shape of goods or of their packaging, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings.” As per the article, there would be three essentials of a valid trademark i.e it must be a sign, capable of being graphically represented and distinctive in character. The co-joint reading of the judgment of *Libertel* and Article 2 of the Directive entails colour per se can be protectable as a trademark if it fulfils three above-mentioned essentials. For a proper understanding, it is imperative to have a brief overview of *Libertel* decision.

Phase III: After 2010

This phase is a follow-up of the phase II which although witnessed certain uncertainties over the registration of single colour marks on a case-to-case basis, but, never altered the essential tests laid down in the Phase II. The judicial pronouncements in this phase abided by the high standards set up in the *Libertel* case.

However, the case of *Cadbury UK LTD v. Nestle*¹⁴ has often been cited as against the registration of single colour marks but it is a misconceived fact. However, the objective analysis of the decision leads us to the conclusion it does not invalidate the protection granted to single colour marks per se. The Cadbury wished to register the purple colour for its acquired distinctiveness, however, the same was challenged by Nestle. The Court referred to multiple judicial pronouncements also scrutinized the Article 2 of the Trade Mark Directives of 2008. The Court came to a well-thought of conclusion that as per the description, the Cadbury does not seek to register the purple colour per se but sought to register different marks which were predominantly corresponded with the purple colour. Thus, it could be said that the protection was rejected as it falls short of clarity, specificity and not due to the fact that single colour marks are not registrable per se.

Recently, General Court in the case of *Glaxo Group Ltd. V. European Union Intellectual Property Office*¹⁵, although rejected the shade of purple colour as trademark but upheld the registrability of single colour marks if it fulfills the set high standards.

ESSENTIAL INPUTS REQUIRED FOR THE REGISTRATION OF SINGLE COLOUR MARKS

This chapter sought to provide the standards which are required for the registration of single colour marks. The chapter attempts to list down the high standards after a careful review of international perspective especially USA and EU jurisdictions. This chapter tries to combine the learnings of previous chapter in order to develop well-structured standards for the registration of single colour marks.

Single colour marks have attained a valid acceptance in a number of jurisdictions. However, the standards for its registration are set on a much higher pedestal than what is required for the registration of combination of colours. After a careful examination of the existing literature and the foreign jurisprudence especially USA and EU, two tests are determined which the court should look into while adjudicating upon the issue of registration of single colour marks. The first test is that the colour per se should not be

¹⁴ Cadbury UK Ltd v. Société des Produits Nestlé SA, [2013] EWCA Civ 1174.

¹⁵ Case T-187/19.

functional in nature. It should breach the functionality doctrine. The second test is that the single colour should have acquired a secondary meaning i.e. distinctive in nature.

- **Test of Functionality**

A trademark is said to be functional in nature when it is “*essential to the use or purpose of the product or affects the cost or quality of the product.*” It has been time and again observed by the judicial authorities that the trademark can be protected and registered if it is not functional in nature. The US Supreme Court in the case of *Qualitex* made a renowned observation about the functionality theory. As per the court, “*a trademark shall be registered unless exclusive use of the feature would put competitors at a significant non-reputation related disadvantage.*”

To have a more detailed understanding about the functionality perspective, a reference to one of the US Supreme Court cases is worthwhile i.e. *Kellogg Co. v. National Biscuit Co.*¹⁶ The cereal's pillow-like look and the term "Shredded Wheat" were both sought to be registered by the Kellogg Company. Neither of the two received any protection since the court found that the desired registrations are beneficial for the goods for which they are being sought. The least costly grain processor formed the cereal into pillows automatically. The court further ruled that when an article can be produced by every manufacturer in the industry, no manufacturer can claim exclusivity in the form that the public has become accustomed to seeing the product in. The court argued that the pillow-shaped product identified the product itself rather than the source of the product. The functionality feature of a trademark can be categorised into two types i.e. utilitarian functionality and aesthetic functionality. The legal pronouncement over the utilitarian functionality is very much clear and definite while it is very much unclear and dispersed over the aesthetic functionality. A colour is said to be utilitarian functional if it is essential to the use or purpose of the article, or affects the cost or quality of the article. In the case of *Blue Frozen Desserts (Ambrit v. Kraft)*¹⁷ where the court applies utilitarian functionality and rejected the colour trademark. The court rejected the Ambrit's request for protecting the blue colour on the premise that the colour royal blue which is used for packaging purposes of frozen desserts is functional in nature and the same cannot be trademarked. Functionality may also be aesthetic in nature when consumers purchase the products for their aesthetic appeal. For the assessment of aesthetic functionality, apart from satisfying the test of utilitarian functionality, an additional factor needs to be ascertained for finding out aesthetic functionality, a feature is functional in nature if its usage would put the competitors at a competitive disadvantage. The principle of aesthetic functionality has not received much acceptance. It is considered much weaker than utilitarian functionality.

- **Secondary Meaning or Acquired Distinctiveness**

A trademark for attaining protection as well as to be registered needs to be sufficiently distinctive in nature so as to be capable of being identified with the source of goods. A trademark can have ‘acquired distinctiveness’ i.e. achieve distinctiveness over a considerable period of time or it can be inherently distinctive in nature.¹⁸ Pertaining to the issue of registrability of single colour marks, courts have often delved into the issue that whether colour per se can be inherently distinctive or it can only acquire distinctiveness.

However, with time the courts have settled this issue and held that colour cannot be inherently distinctive in nature. In the Walmart ruling, the US court elucidated the regulation, noting that color by itself is not registrable and that it needs to be combined with another feature to be acknowledged as a legitimate

¹⁶ 305 U.S. 111 (1938).

¹⁷ *Ibid* at 5.

¹⁸ V.K. AHUJA, INTELLECTUAL PROPERTY RIGHTS IN INDIA (2nd edn, Lexis Nexis 2015).

trademark. When a product characteristic or term is predominantly used by the general public to identify the product's source rather than the product itself, it is considered to be a secondary meaning of a trademark. But the question that has to be answered is how a manufacturer can prove that their product now serves a secondary function. You can use the following evidence to support your claim that a product has "acquired distinctiveness."

Survey Evidence

Survey evidence is one of the accepted means through which secondary meaning can be granted to a trademark. In the case of *Owens-Corning*¹⁹, In order to prove that Owens-Corning's vast advertising campaigns had effectively registered "pink insulation glass" as a product, survey evidence was submitted.

❖ ***Consumer Testimony***

A compelling part of evidence to support the claim that the product has been unavoidably distinguished by the trademark is direct consumer testimony. The entire purpose of registering a trademark is to properly link a product to its source, and if the intended market links a trademark with the producer's products, it is quite likely that a secondary meaning has been added. An example of consumer testimony can be the case of *Qualitex* which relates to the issue of registration of green-gold colour for the dry-cleaning pads. The court in that case determined that because consumers connected the green-gold colour of the press pads with Qualitex, it had taken on a secondary connotation. Some customers ordered Qualitex pads and only specified their colour.

❖ ***Amount Invested in Advertisement***

The amount that a manufacturer spends on advertising to get a market share for his product is a highly significant element in deciding whether or not a secondary meaning is attached to it. The Owens-Corning court accepted that the amount of advertising expenditures by itself has been found to provide strong proof of secondary meaning. Owens Corning revealed that the corporation had spent more than \$42 million on consumer advertising between 1956 and 1981 in order to sell its pink insulation boards. The amount of money spent on advertising has also been suggested by authors as a very significant indicator that the target audience associates a particular colour with the products of a particular producer.²⁰

MAINSTREAMING THE INDIAN LEGAL FRAMEWORK: UNRAVELLING THE CONUNDRUM PERTAINING TO SINGLE COLOUR MARKS

This chapter tries to examine and explore the inconsistencies prevalent with respect to single colour marks within India legal framework. The chapter attempts to analyse and delve into the inconsistent judicial pronouncements especially the recent cases of Christian Louboutin within the Delhi High Court. The main aim of this chapter is to develop a harmony among Acts, Rules, Judicial pronouncements and collaborate with suitable foreign learnings discussed in the previous chapters in order mainstream the law relating single colour marks within Indian jurisdiction.

The Indian jurisprudence with respect to single colour marks has been very much confusing. Till date there is no such settled position of law. Time to time, courts have commented and even attempted to delve on the aspect of legality of single colour marks but to utter shock till date we haven't witnessed a smooth line of approach which could be capable of streamlining the position of law.

¹⁹ *Ibid* at 8.

²⁰ Sakshi Mahajan & Aastha Tandon, Legal Acceptability of Single-Colour as a Trademark. 4 CHANAKYA NATIONAL LAW UNIVERSITY LAW JOURNAL. (2014).

One of the initial cases which sought to opine upon the aspect of single colour marks was *Colgate Palmolive Company v. Anchor Health And Beauty Care Pvt. Ltd.*,²¹ which was before the Delhi High Court. In the said case, the court observed, “...**Even a single colour has been held to be a trade mark. There may be exception also. Exception is that where the colour cannot be protected as the blue colour is for the Ink and red colour is for the lipstick. Red and white has nothing to do with the pink. Teeth as white line and Gum as Pink colour alone at least sometimes can meet the basic requirements as a trade mark. Colour depletion theory is unpersuasive only in cases where a blanket prohibition is being sought.**”

However, an altogether different opinion was expressed by the Delhi High Court in the case of *Cipla Limited v. M.K. Pharmaceuticals*²² wherein the court observed, “...It is settled law that there can be no monopoly over colours...Merely because plaintiff has started using a particular colour for its tablets plaintiff does not get monopoly over colour so that no one else can use that colour. The medicines are not bought by colours by the customers.”

There have been successful registration of single colour marks within India. Entities like Telekom AG(#1462271- magenta colour label) and Victronix AG(#1394234- brown colour label) have successfully got the registration of their single colour marks in India.²³ But the recent uncanny judicial developments in the Christian Louboutin case have made us realised that a solid judicial or legislative instruction is mandatory in order to unmystify the confusion surrounding the single colour marks.

In February 2016, Christian Louboutin carried out a survey and initiated infringement proceedings for the unauthorised use of their trademarks. Along with registered word marks of Christian Louboutin, their group of registered trademarks included the registration of red-coloured soles for footwear for ladies. The Delhi High Court then handed down three separate rulings over the course of eight months, which brought to light the lack of judicial guidance and precedent for judging single colour trademark issues. All the three rulings have similar focus of attentions with the exception of being the case of *Christian Louboutin v. Abubaker*, wherein the infringement was being impleaded and not the word mark. The rulings depicted conflicting judicial dictums necessitating a brief review of all the three.

- ***Christian Louboutin v. Pawan Kumar***²⁴

The said judgment was delivered by the single bench of the Delhi High Court which turned out to be a display of judicial misunderstanding. After carefully reviewing the complaint that was presented to her, Justice Gupta ruled that the plaintiff's "red sole" mark amounted to being a well-known trademark in the Indian context. The court skips over the issue of the "red sole" mark's legality while considering infringement analysis and whether the mark can be said to have the characteristics of a “well-known mark”.

- ***Christian Louboutin v. Abubaker***²⁵

The said case was delivered by the Justice Mehta of the Delhi High Court which actually delved into the issue of single colour marks out of all three rulings. The court determined that the plaintiff's red-coloured sole mark is not registrable within Indian legal framework. The court in well-structured manner dismissed the registration of single colour marks. For such dismissal, Justice Gupta relied on two main arguments.

²¹ 2003 SCC OnLine Del 1005.

²² 2007 SCC OnLine Del 1212.

²³ *IP Expressions, A biannual publication from the Office of Controller General of Patents, Designs and Trademarks, India Vol No. 1 Issue 2, January, 2015.*

²⁴ 2017 SCC OnLine Del 12173.

²⁵ 2018 SCC OnLine Del 9185.

The Trade Marks Act of 1999's Section 2(m) is the basis for the first argument. It offers an inclusive definition of the term "mark" that covers "combination of colours." As per Justice Mehta's interpretation, the definition only provides for combination of colours, so single colour marks are't permitted to be registered. The court observed, "*Combination of colours is sine qua non, and meaning thereby that quite obviously one single colour, as contra-distinguished from combination of colours, cannot be a mark falling in the definition of mark.*" The second argument rests over the fact that an infringement suit cannot lie over the red-coloured sole because of functionality issue as per Section 30(2)(a). For determining the issue of functionality, the court exclusively referred the *Qualitex* decision.

- ***Christian Louboutin v. Ashish Bansal***²⁶

This is the newly decision delivered by the Justice Khanna of Delhi High Court. However, in this ruling, the Plaintiff's mark was not given the distinction of being a well-known mark. Punitive damages were granted, and the court ruled that the defendants were responsible for violating the registered trademarks and domain names. Justice Khanna did not, however, analyse the legality of the mark itself, like Justice Gupta. Additionally, Justice Mehta's decision regarding a related issue and the same plaintiff had already been made, but that opinion is also not referred.

THE WAY OUT

In today's world with new developments in technologies, different companies are coming up with different and unique classes of marks. There is no iota of doubt that India's intellectual property rights domain is in its nascent stage but we need to grow with time and imbibe and implement appropriate learnings so that we can become masters of this subject-matter. The protection to single colour marks is one such area where the judicial confusion appertaining to the matter reflects our state of nascency. We still have not come to a definite conclusion whether to accept it or not. The Indian legal framework is not very much clear about legal aspect of single colour marks but a harmonize reading of Act, Rules, their correct interpretation and imbibing appropriate foreign learnings can very well help in accumulating single colour marks within the Indian domain.

The basic definition of the term "*mark*" is provided in Section 2(m) of the Trademark Act, 1999 which says, "*mark includes a device, brand, heading, label, ticket, name, signature, word, letter, numeral, shape of goods, packaging, or combination of colours or any combination thereof.*"²⁷ The said definition of the mark is an inclusive definition and not an exhaustive definition. It can accompany single colour marks. Scholarly opinion holds that Section 2(m) is an inclusive definition that encompasses all marks, even those made up entirely of a single colour, with or without the arrangement of any additional signs or words. Apart from this, the acknowledgement of single colour marks within the Indian domain can very well be indicated by the Manual of Trademarks, Practice and Procedure, 2015 wherein it must be protected with thorough documentation of acquired distinctiveness, and protection is only given to the extent of that specific shade of colour. However, for obvious reasons, the standards have been kept high. Additionally, the Frequently Asked Questions (FAQ's)¹⁰ published by the Controller General of Patents, Designs, and Trademarks make it abundantly clear about protection of single colour.

²⁶ 2018 SCC OnLine Del 10205.

²⁷ Trade Marks Act, 1999, § 2(m), No. 47, Acts of Parliament, 1999 (India).

The Indian judiciary has time to time reflected certain concerns against the registration of single colour marks. These concerns appertain to the issue of graphical representation, acquired distinctiveness and functionality issues. The said concerns need to be alleviated in order to set the jurisprudence on time.

- **Concern of Graphical Representation**

A co-joint reading of Section 2(m) and 2(zb) states that when a mark is graphically represented then only it will be turned into a trademark. Section 2(k) of the Trademark Rules, 2017 states that graphical representation means, “*capable of being represented in paper form and includes representation in digitised form.*” It was asserted that a single colour is incapable of being graphically represented in an application form. A colour sample by itself wouldn't meet the said requirement because it would be susceptible to deterioration. Additionally, the background on which it is printed or placed may cause a slight change. However, to resolve the conundrum of graphical representation a reference to *Libertel* case is very much recommended. The verdict states that for a color to be registrable, it must be visually represented in a way that is self-contained, equally accessible, understandable, persistent, and objective. For a precise graphical representation, the application should include the sample as well as a verbal description and the color's internationally recognised colour identification code. Using a globally recognised identifying code, such as the Pantone Classification System, can satisfy this 'objective' criteria.

- **Concern of Acquired Distinctiveness**

It has been time and again expressed that colour per se cannot be inherently distinctive in nature. It can only assume acquired distinctiveness. But the Indian courts have faced the dilemma that whether colour per se can acquire distinctiveness. No doubt the standards set are high in nature but yes single colour can assume acquired distinctiveness. In my opinion, if the colour per se is able to acquire secondary meaning as laid down in *Qualitex* decision then it can be held as distinctive in nature. The suggested evidences for proving distinctiveness are consumer testimonials, survey evidence and amount invested in advertisement. The Courts in *Cadbury* case and *Owens Corning* case appreciated the survey evidence for determining their respective colours with the source of goods.

- **Concern of Functionality**

Another major concern attached to single colour marks is the issue of functionality. Justice Mehta in *Christian Louboutin v. Abubaker* case asserted that an infringement suit cannot lie over the red-coloured sole because of functionality issue as per Section 30(2)(a). Issue of functionality has been reflected on a flawed dynamics. Therefore, for the proper assessment of functionality concerns, an objective test is mandatory. The following characteristics may help in denoting functioning. First, the design was covered by an expired utility patent that revealed its practical benefit; Second, the promotion of the design's practical benefits through advertisement campaigns; Thirdly, the presence of substitute designs; and, finally, the fact that the design is executed using relatively inexpensive or straightforward manufacturing techniques.

CONCLUSION

Any manufacturer should not be permitted to benefit from the brand value built up by another manufacturer via ongoing and extensive use. Producers should be protected if they can demonstrate that their goods have become unique in the market and that the intended audience connects a particular colour with them. The interests of businesses who implement comprehensive plans and incur costs in doing so should not be adversely affected by the legal framework's failure to specifically address the registrability of single color marks. A single colour has been successfully used by firms like Cadbury, Louboutin, and

many others to define the identity of their products. These companies' efforts and legal rights should be properly preserved.

In United States as well as in the European Union, the jurisprudence over single colour marks is very much settled. However, the position within the Indian context is very much uncanny which still needs to be unmystified. There is no doubt that for granting protection to single colour marks, a plus factor is required but that does not speak for the case that it is unregistrable in nature. The author through sound arguments and appropriate foreign learnings have attempted to bring down the case of single colour marks within Indian legal framework .

Let's hope that the Indian Legal Framework witnesses this unique change in its unique colour.